

NOTICE OF APPEAL
UNITED STATES COURT OF APPEALS FOR
THE FEDERAL DISTRICT

In the matter of :

FRANK J JAKUBAITIS
2487 McCoy Drive
Tustin California 92782
Tel: 714-573-9801 714-241-0900
Application Serial Number : 09607202
Filed June of 1999 - February 20, 2007

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GENERAL COUNSEL
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U.S. PATENT
AND
TRADEMARK OFFICE

V.S.

THE PATENT APPEALS BOARD OF THE USPTO :
STUART S LEVY ROBERT E NAPPI ANTON W FETTING &
ROBERT POND, PATENT EXAMINER

NOTICE

Please take notice that on this 17th day of April 2007 Frank J Jakubaitis of Tustin California, hereby files this notice OF APPEAL and appeals to the United States Court Of Appeals for the Federal District in the above captioned case.. Said notice is accompanied by the proper fees, and is hereby timely filed

Dated

April 17, 2007
Frank J Jakubaitis Frank J Jakubaitis

**Notice Of Appeal to the United States Court of
Appeals for the Federal Circuit**
Re : 09607202

Please take notice that :

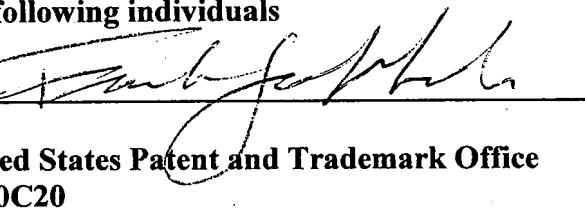
Frank Jakubaitis
2487 McCoy Drive
Tustin, California 92780
Telephone Contact Number : 714-767-7193 / 714-241-0900

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**Hereby serves this notice of appeal on the Director, and General Counsel of the
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I Frank Jakubaitis hereby state under the penalty of perjury that this notice of appeal was deposited at the United States Post Office on April 16th, 2007 sent by registered mail to the following individuals

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Notice Of Appeal to the United States Court of
Appeals for the Federal Circuit
Re : 09607202

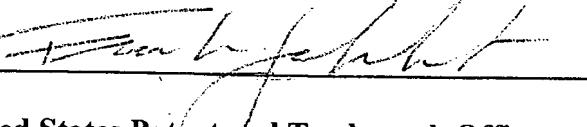
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3101 W SUNFLOWER AVE
SANTA ANA, CA 92799-9998
04/16/07 04:10PM

***** WELCOME TO *****

SANTA ANA R&DC
3101 W SUNFLOWER AVE

04/16/07 04:10PM

Transaction Number 179
USPS® # 056936-9552

Transaction Number 056936-9552
1. Priority Mail® FR Env 178
USPS® # 056936-9552

1. Priority Mail® FR Env 4.55
Destination: 22313 4.55
Weight: 0 1b. 1.60 oz.
Total Cost: 4.55
Base Rate: 4.05
Label #: 0413 1797 9250 5808 6401
Delivery Confirmation™

Subtotal .50
Total Charged .50

DebitCard 4.55
DebitCard 4.55

4.55

DebitCard <23-902500388-99>
ACCT. NUMBER 0507 TRANS # 832 AUTH 361951
RECEIPT # 038784

DebitCard 4.55
ACCT. NUMBER 0507 TRANS # 833 AUTH 962655
RECEIPT # 038785

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The opinion in support of the decision being entered today was *not* written for publication in and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK J. JAKUBAITIS

MAILED

FEB 20 2007

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal 2006-2420
Application 09/607,202
Technology Center 3600

Decided: February 20, 2007

Before STUART S. LEVY, ROBERT E. NAPPI, and ANTON W. FETTING,
Administrative Patent Judges.

ANTON W. FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1, 4 through 9, 12 through 15 and 16 through 19, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

We AFFIRM.

BACKGROUND

The appellant's invention distributes digital works which allows consumers to purchase Internet-based products and services at traditional retail merchants without the need of a computer or Internet connection at the time of purchase. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for distributing digital works among a retail merchant having a merchant node, a remote server, and a customer at a customer node, each digital work having identification data associated therewith, the remote server being intermittently coupled through a communications link which includes a communications network to the customer node, the method comprising the steps of:
 - storing the digital works and their associated identification data on a memory of the remote server;
 - purchasing from the retail merchant a package including a card associated with a desired one of the digital works, wherein the card includes a card identifier, the card identifier being displayed on an outer surface of the card, the card identifier being a code that includes the desired digital work's identification data to uniquely identify the digital work and the package and card being purchased, the outer surface of the card or the package further displaying a description of the content of the digital work to be downloaded;
 - sending a request from a merchant node associated with the retail merchant to the remote server to set a status of the desired digital work as available for one-time access based on the card identifier of the card associated with the digital work, the remote server receiving the request and searching the digital works stored on the remote server for the desired digital work specified by the card identifier in the received request from the merchant node and setting the status of the desired digital work as available for access;

sending a request to access the desired digital work from the customer node through the communications network to the remote server, the request specifying the desired digital work's identification data included in the card identifier displayed on the outer surface of the purchased package;

receiving at the remote server the request to access the desired digital work;

searching the digital works stored on the remote server for the desired digital work specified by the identification data associated with the card identifier displayed on the outer surface of the purchased card in the received request;

identifying the digital work based upon the received identification data;

transmitting the desired digital work from the remote server through the communications network to the customer node;

receiving at the customer node the desired digital work; and

storing the desired digital work on a memory of the customer node such that the digital work is available for subsequent use by the customer at the customer node after the customer logs off of the remote server.

PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Freeny	US 4,528,643	Jul. 9, 1985
Reber	US 5,995,105	Nov. 30, 1999 (Oct. 4, 1996)
Fiala	US 5,918,909	Jul. 6, 1999 (Jul. 16, 1997)
White	US 6,169,975 B1	Jan. 2, 2001 (Jul. 9, 1997)

REJECTIONS

Claims 1, 6 through 9, 13 through 15 stand rejected under 35 U.S.C. § 103(a) as obvious over Reber, Fiala and Freeny.

Claims 4 and 12 stand rejected under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny and Official Notice.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny and White.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (mailed Jan. 13, 2006) for the reasoning in support of the rejection, and to appellant's brief (filed Oct. 17, 2005) and reply brief (filed Mar. 17, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow.

Claims 1, 6 through 9, 13, 14 and 15 rejected under 35 U.S.C. § 103(a) as obvious over Reber, Fiala and Freeny.

We note that the appellant argue these claims as a group. Accordingly, we select claim 1 as representative of the group.

The issues under contention are:

- Whether the art shows distributing digital works, including using package and card displaying a description of the content of the digital work to be downloaded (Br. 7; Reply Br. 2-6).
- Whether the art shows purchasing from a retail merchant a package including a card with a card identifier displayed on its outer surface that contains a code to uniquely identify the digital work (Br. 7-10; Reply Br. 2-11).
- Whether the art shows sending a request from the retail merchant to a remote server to set a status of the desired digital work as available for one-time access (Br. 11-13; Reply Br. 11-15).
- Whether there is motivation to combine the references and whether, once combined, they would have yielded the claimed invention (Br. 13-14).

The facts pertinent to the issues under contention are as follows:

1. Reber describes downloading a file identified by a URL (Uniform Resource Locator) with the file or ftp protocols (Col. 10, Lines 1-22).
2. A file is a digital work.

3. Reber Fig. 2 portrays a device (40) with a human-viewable image (42) and machine readable data (46).
4. Reber's device (40) is a species of a package.
5. Reber's image (42) is a species of a description of the content of the product stored for download, ie. the content of the digital work to be downloaded. This is further clarified at Col. 3, Lines 63-66,

The first human-viewable image 14 can include textual information and/or graphical information which provide an intuitive and/or understandable representation of the resource.

referring to image 14 in Fig. 1, which corresponds to image 42 in Fig. 2.

6. Reber's machine-readable data (46) is a species of an identifier that uniquely identifies the digital work stored for downloading.
7. Freeny shows purchasing digital works from a retail merchant at Col. 4, Lines 16-18, where it "permits sale of material objects embodying information in a more efficient, economical and profitable manner."
8. Freeny shows sending a request from the retail merchant to a remote server to set a status of the desired digital work as available for one-time access at Col. 13, Lines 25-48, teaching that each access requires payment, and therefore, there is only one access per payment.

It should be noted that additional data also can be communicated in connection with request reproduction codes. For example, a consumer credit card number also might be communicated with each request reproduction code so the owner of the information could approve the sale and, in effect, charge the sale to the consumer credit card number. If a consumer desired to pay cash, the owner of the point of sale location could input the owner's credit card number so the owner of the information could approve the sale and, in effect, charge the sale

to the credit card number of the owner of the point of sale location. In this manner, the owner of the information receives directly the compensation for each sale of a recording and such compensation is received before the reproduction is authorized. The owner of the point of sale location would collect from the consumer compensation for the blank material object (8-track tape or cassette tape, for example) and this would be a sales transaction independent of the owner of the information. Also, it should be noted that various other data could be inputted into the manufacturing control unit 34 in connection with a request reproduction code for inventory of material objects control or other general accounting data, if desired.

9. Freeny provides a suggestion for applying its metered download system to Reber as a "means for reproducing or manufacturing material objects at point of sale locations only with the permission of the owner of the information, thereby assuring that the owner of the information will be compensated in connection with such reproduction" (Col. 4, Lines 8-13).

10. Applying Reber's claim elements of a

card associated with a desired one of the digital works, wherein the card includes a card identifier, the card identifier being displayed on an outer surface of the card, the card identifier being a code that includes the desired digital work's identification data to uniquely identify the digital work and the package and card being purchased, the outer surface of the card or the package further displaying a description of the content of the digital work to be downloaded to Freeny's claim elements of

sending a request from a merchant node associated with the retail merchant to the remote server to set a status of the desired digital work as available for one-time access based on the identifier of the digital work, the remote server receiving the request and searching the digital works stored on the remote server for the desired digital work specified by the identifier in the received request from the merchant node and setting the status of the desired digital work as available for access

would yield the claim elements under contention of

purchasing from the retail merchant a package including a card associated with a desired one of the digital works, wherein the card includes a card identifier, the card identifier being displayed on an outer surface of the card, the card identifier being a code that includes the desired digital work's identification data to uniquely identify the digital work and the package and card being purchased, the outer surface of the card or the package further displaying a description of the content of the digital work to be downloaded;

sending a request from a merchant node associated with the retail merchant to the remote server to set a status of the desired digital work as available for one-time access based on the card identifier of the card associated with the digital work, the remote server receiving the request and searching the digital works stored on the remote server for the desired digital work specified by the card identifier in the received request from the merchant node and setting the status of the desired digital work as available for access.

From the above facts, we conclude that

- The art distributes digital works, package and card displaying a description of the content of the digital work to be downloaded.
- The art shows purchasing from a retail merchant a package including a card with a card identifier displayed on its outer surface that is a code to uniquely identify the digital work.
- The art shows sending a request from the retail merchant to a remote server to set a status of the desired digital work as available for one-time access.
- There is motivation to combine the references and, once combined, they would have yielded the claimed invention.

In particular, the appellant's contention that Reber's URL references are not digital works for download fails to appreciate Reber's explicit recitation of digital files for downloading, cited in Fact # 1. This similarly addresses the appellant's contention that URL's are not identification, because the URL specifies the file to be downloaded and therefore identifies the file. Further, the appellant's contention that Reber does not sell or meter its product fails to appreciate that Freeny describes this as a distribution mechanism for digital files such as Reber's, and that Freeny inherently meters the download for on-time access for each payment by virtue of its royalty system in which the owner of the information receives directly the compensation for each sale of a recording and such compensation is received before the reproduction is authorized.

Therefore, we find the appellant's arguments to be unpersuasive. Accordingly we sustain the examiner's rejection of claims 1, 6 through 9, 13, 14 and 15 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala and Freeny.

Claims 4 and 12 rejected under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny and Official Notice.

There are no issues under contention as to these claims and they depend from independent claims 1 and 9 whose rejection we sustained above. Accordingly we sustain the examiner's rejection of claims 4 and 12 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny and Official Notice.

Claim 5 rejected under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny and White.

There are no issues under contention as to this claim and it depends from independent claim 1 whose rejection we sustained above. Accordingly we sustain the examiner's rejection of claim 5 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny and White.

CONCLUSION

To summarize,

- The rejection of claims 1, 6 through 9, 13, 14 and 15 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala and Freeny is sustained.
- The rejection of claims 4 and 12 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny and Official Notice is sustained.
- The rejection of claim 5 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny and White is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

